

Customer No. 01333

Attorney Docket No. 83304B/EIS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of
Lou Chauvin et al.

**SYSTEM, METHOD AND SOFTWARE
PRODUCT FOR ALLOWING A
CONSUMER TO ORDER IMAGE
PRODUCTS OVER A COMMUNICATION
NETWORK FROM A PLURALITY OF
DIFFERENT PROVIDERS**

U.S. Serial No. 09/944,549

Filed: 31 August 2001

Group Art Unit: 3691

Examiner: Alexander G. Kalinowski

Confirmation No.: 3066

Mail Stop - APPEAL BRIEF-PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

CORRECTED

APPEAL BRIEF PURSUANT TO 37 C.F.R. § 41.37 and 35 U.S.C. § 134

Table Of Contents

<u>Table Of Contents</u>	i
<u>Real Party In Interest</u>	1
<u>Related Appeals And Interferences</u>	1
<u>Status Of The Claims</u>	1
<u>Status Of Amendments</u>	1
<u>Summary of Claimed Subject Matter</u>	1
<u>Grounds of Rejection to be Reviewed on Appeal</u>	4
<u>Arguments</u>	4
<u>Summary</u>	9
<u>Conclusion</u>	9
<u>Appendix I - Claims on Appeal</u>	10
<u>Appendix II - Evidence</u>	n/a
<u>Appendix III – Related Proceedings</u>	n/a

APPELLANT'S BRIEF ON APPEAL

Appellants hereby appeal to the Board of Patent Appeals and Interferences from the Examiner's Final Rejection of Claims 1-22 which was contained in the Office Action mailed March 1, 2005.

A timely Notice of Appeal was mailed on May 31, 2005.

Real Party In Interest

As indicated above in the caption of the Brief, the Eastman Kodak Company is the real party in interest.

Related Appeals And Interferences

No appeals or interferences are known which will directly affect or be directly affected by or have bearing on the Board's decision in the pending appeal.

Status Of The Claims

Claims 1-22 are pending in the application. These claims have been rejected and are being appealed.

Appendix I provides a clean, double spaced copy of the claims on appeal.

Status Of Amendments

The claims stand as indicated in Appendix I.

Summary of Claimed Subject Matter

The present invention is directed to a method, system and software product for the selecting of a digital photographic service provider from a plurality of different service providers for providing a selection of photographic services with respect to a digital image over a communication network. *See* page 4, lines 7-11; Fig. 1.

Independent Claim 1:

The present invention includes a method of selecting a digital photographic service provider from a plurality of different service providers at a user location remote from the service provider. The method steps include providing a services directory of service providers on a server accessible over a network, page 7, lines 11-23; Fig. 2, element 54. A user provides a criterion for selecting a service provider, page 11, lines 8-20; page 13, lines 12-14; page 20, lines 5-11; Fig. 3, element 110. Then the user is automatically provided with a list of one or more service providers based on the criterion, page 11, lines 12-13; Fig. 3, element 114; page 13, lines 12-14; and page 20, lines 22-30. The user is then able to select one of the service providers from the list, page 13, lines 14-16; Fig. 3, element 116; page 20, line 30 - page 21, line 13; Fig. 4C, element 224. The user then sends a request for a desired service to the selected service provider, page 21, lines 14-18; Fig. 3, element 120; Fig. 4E, element 242. Then the selected service provider provides the service, page 21, lines 25-29; Fig. 3, element 124.

Independent Claim 20:

The present invention includes a system adapted for providing imaging services over a network that includes a device with a user interface for receiving requests from a user and which also includes a network interface connected to a network, page 10, lines 6-15; Fig. 2, element 46; Fig. 1, element 32. A number of service providers are also connected to the network, page 7, line 24 - page 8, line 12; Fig. 1, elements 14, 16, 18, 20; Fig. 4C, element 224. A computer communicates over the network to the user device and includes a services directory with a number of service providers having descriptive associated information, page 10, lines 16-30; Fig. 2, elements 54, 62, 64, 66, 69, 70; page 20, lines 22-27. On the device with the user interface, a user enters a criterion, page 13, lines 12-14; Fig. 3, element 110; page 20, lines 4-21. The computer automatically provides a list of service providers based on the criterion, page 11, lines 9-20; Fig. 3, element 114; page 20, lines 22-27, and a selected service provider provides a requested service, page 21, lines 25-29; Fig. 3, element 124.

Independent Claim 21:

The present invention also includes a computer software product for linking a digital camera user to a service provider selected from a group wherein the software will activate providing a services directory of the service provider group over a network, page 7, lines 8-13; Fig. 2, elements 40 and 54; page 9, lines 5-8; Fig. 3, element 100; page 10, lines 1-15; page 13, lines 6-24; and page 19, lines 3-10. The user communicates a criterion to the service directory, page 13, lines 6-16; Fig. 3, element 110. The software automatically provides the digital camera user with a list of service providers based on the criterion, page 13, lines 6-24, from which the user selects a service provider, page 13, lines 14-24, and provides a request for a service, page 13, lines 6-24. The service provider then provides the desired service, page 13, lines 6-24.

Independent Claim 22:

The present invention includes a method of linking a customer to a service provider selected from registered members, page 7, lines 11-15; page 7, line 30 - page 8, line 2; page 11, lines 21-25; Fig. 2, element 58. The method involves providing a directory accessible over a network which includes entries for a plurality of services, each associated with a service provider, page 7, lines 8-23; Fig. 1, elements 16, 18, 20; Fig. 2, element 54; Fig. 3, element 114; Fig. 4C, element 224. The customer provides a digital image and a criterion, page 13, lines 25-29; Fig. 3, elements 110, 124; page 21, lines 25-29; Fig. 4D, element 202, and is automatically provided with a list of service providers based on the criterion, page 4, lines 9-13; Fig. 3, element 114; page 20, lines 22-30. The customer then selects a service provider, page 20, lines 27-30; Fig. 3, element 116; Fig. 4C, element 224, and requests a desired service and provides the digital image, page 8, lines 13-19; page 9, lines 10-13 and 18-21; page 12, lines 11-14; page 13, lines 14-18; Fig. 3, elements 120, 124; page 21, lines 14-26; Fig. 4D, element 202. The service provider then provides the desired service, page 9, lines 21-27; page 13, lines 18-24.

Grounds of Rejection to be Reviewed on Appeal

The following issues are presented for review by the Board of Patent Appeals and Interferences:

1. Whether Claims 1-5, 10, 11, 13, and 17-22 are obvious under 35 USC § 103(a) as being unpatentable over U.S. Patent No. 6,324,521 to Shiota in view of U.S. Patent Application Publication No. 2003/0005132 A1 to Nguyen.

2. Whether Claims 6-9 are obvious under 35 USC § 103(a) as being unpatentable over Shiota in view of Nguyen and further in view of U.S. Patent No. 5,918,054 to Jury.

3. Whether Claims 12 and 16 are obvious under 35 USC § 103(a) as being unpatentable over Shiota in view of Nguyen and further in view of U.S. Patent Application Publication No. 2002/0036696 to Takemoto.

4. Whether Claims 14 and 16 are obvious under 35 USC § 103(a) as being unpatentable over Shiota in view of Nguyen and further in view of Examiner's Official Notice.

Arguments

A. Background

Today, the ordering of image products, good and/or services are limited to the goods or services provided by a single provider. These are typically closed systems where the user accesses a single service provider over the Internet and orders from the limited list of goods or services offered by that provider. Quite often a particular service provider is not able to provide a whole variety of different goods or services due to its limited capabilities and business directions. The user must then search for a suitable provider. The present invention seeks to solve the problems of the prior art by providing a directory service layer that provides a list of service providers where service providers can publish their services, definitions, capabilities and locations and allow a user a greater selection of services in an efficient manner. Given a set of

services available through the directory service layer, users are able to find an appropriate service provider by providing a criterion as to the particular types of goods or services it wishes to obtain. The directory service layer provides a list of potential service providers to the users from which the user may select a particular service provider. Thus, the user is no longer limited to a particular service provider when desiring a particular type of goods or services. In addition, a larger variety of different goods or services can be quickly obtained and accessed even with respect to different competing providers.

B. The Rejection of Claims 1-5, 10, 11, 13, and 17-22 over Shiota in view of Nguyen

Claims 1, 20, 21, and 22 are independent claims wherein Claims 2-19 depend at least ultimately upon independent Claim 1.

Independent Claims 1, 20, and 21 are directed to method, system and software products for allowing the selection of a digital photographic service provider from a plurality of different service providers and providing a photographic image service.

The independent claims are directed to a method, system or software for selecting a digital photographic service provider from a plurality of different service providers and providing a photographic image service with respect to at least one digital image located at a user location remote of said selected photo service provider. The invention includes providing a service directory on a server accessible over a communication network which includes an entry for a plurality of different unrelated service providers. The claims further include providing a criterion to the server with respect to a selection of a service provider and automatically providing the user with a list of one or more plurality of unrelated different service providers based on said criterion for display on the user display device. The claims include the step wherein the user selects one of the plurality of different service providers on the provided list and the steps directed to a particular service by the user and then providing of the service by the service provider.

The claimed invention can be distinguished from primary cited reference to Shiota by at least the following points:

- 1) the user provides a criterion to the service provider with respect to providing a selection of a service provider;
- 2) that a list of providers is provided to the user based on the criterion provided by the user; and
- 3) that the list comprises one or more unrelated different service providers.

The Examiner suggests that in Shiota, the user provides criterion for the selection of a service provider and in particular refers to column 2, lines 29-33. This portion of the Shiota is directed to the placement of an order by placing input information into a predetermined screen. This does not teach or suggest that the user provide a criterion to the service directory for obtaining a list of different service providers. Quite the contrary, this portion is already dealing with the placement of an order.

The Examiner refers to column 3, lines 5-10 for the providing of a service directory. The passage referred to by the Examiner in column 3, lines 5-10 is directed to the selection by the service provider of where the order is to be fulfilled. This portion of the Shiota reference is dealing with the service center selecting the appropriate laboratory based upon the appropriate equipment to provide the desired product that has been ordered. While Shiota discloses that the customer may select the laboratory that is to output the print, there is no teaching or suggestion that this is based on any criterion supplied by the user. As set forth in column 6, lines 21-22, Shiota discusses the fact that there is provided a number of affiliated laboratories. This affiliation indicates that the selection by the user is based on an already existing affiliation. There is nothing that indicates that the output list is provided in response to a criterion supplied by the user as claimed by applicants. The service providers are not unrelated as also taught and claimed by applicant. Applicant further directs the Examiner to column 9, lines 16-25, that when the customer wishes to receive the print over the counter, the order information data shows the laboratory at which the print is received is referred to, and the laboratory is selected as the laboratory to output the print. As further set forth, when no laboratory is specified in the order

information, the laboratory which stores the high resolution image is selected. (*See* column 9, lines 21-22 of *Shiota*). As previously stated, there is no teaching or suggestion of developing a list of service providers based on a criterion provided by the user.

The Examiner states that *Shiota* fails to disclose the use of a service directory and cites *Nguyen*. Applicant respectfully submits that the *Nguyen* reference does not teach or suggest anything in combination with *Shiota* that would render applicants invention obvious. In this regard, applicant would first like to state that in order to properly combine references there must be some teaching suggestion or motivation to combine the references. The CAFC in *In re Lee*, 16 USPQ2d, 1430, at page 1433 has stated:

“When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness.” ... “The factual inquiry whether to combine references must be thorough and searching” ... It must be based on the objective evidence of record.” ... (“Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for showing of the teaching or motivation to combine prior art references.” ... “(there must me some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant).”

In this regard the distributed service creation and distribution system of *Nguyen* is totally apart and distinct from the *Shiota* reference. The *Shiota* reference is directed to a network photographic service of affiliated laboratories with a central center server for fulfilling an order that a customer placed over the network. This is in contrast to the distributed service creation and distributions of *Nguyen* where there is provided a directory service utility that maintains a registry of service providers. As set forth at paragraph 35 of *Nguyen*, there is provided a directory service utility that is aware of other service communities. There is provided a hierarchical relationship among service clusters 108A that communicate between directory service utilities 316. As set forth in paragraph 39 of *Nguyen*, the cluster 108 of service communities 212 may be built in a scalable way. Each service community

Independent claim 22 is slightly different than independent claim 21 in that independent claim 22 is directed to a method of linking a digital photographic image service requestor to a service provider and includes substantially the same limitations set forth in Claim 1 and therefore is patentably distinct for the same reasons.

The remaining claims depend at least ultimately upon independent Claim 1 and therefore are patentably distinct for the same reasons. The additional references cited by the Examiner against these dependent claims do not detract from the patentability of the independent claims. Accordingly it is believed that the dependent claims are patentably distinct over the cited prior art.

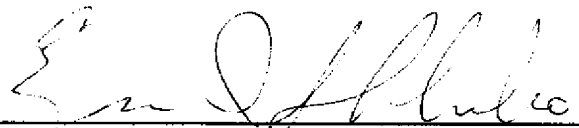
Summary

In summary, Applicant respectfully submits that the present invention is patentably distinct over the cited art.

Conclusion

For the above reasons, Appellants respectfully request that the Board of Patent Appeals and Interferences reverse the rejection by the Examiner and mandate the allowance of Claims 1-22.

Respectfully submitted,



Eugene I. Shkurko, Esq.
Attorney for Appellant(s)
Registration No. 36,678

EIS:cvn
Telephone No.: 585-253-0123
Facsimile No.: 585-477-1148
Enclosure(s)

If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at:
(585) 477-4656.

Appendix I - Claims on Appeal

1. A method of selecting a digital photographic service provider from a plurality of different service providers and providing a photographic image service with respect to at least one digital image located at a user location remote from said selected photographic service provider, comprising:

a) providing a services directory on a server accessible over a communication network which includes entries for a plurality of different unrelated service providers;

b) said user providing a criterion to said server over said communication network for selection of a service provider;

c) automatically providing the user with a list of one or more of said plurality of unrelated different service providers based on said criterion for display on a user display device;

d) said user selecting one of said plurality of different service providers from said list;

e) providing a request for a desired service by said user to the selected service provider; and

f) providing of said desired service by said selected service provider.

2. The method of Claim 1, wherein the criterion comprises a location of a designated recipient.

3. The method of Claim 1, wherein the criterion is selected from at least one of the following:

Brand of image capture device

Language

Retailer

Cost of service

Specific product characteristics

Delivery time

Delivery method

Delivery reach

Specific provider characteristics

Access time

Ability to ship to specific location.

4. The method according to Claim 1 wherein said automatically providing of said list is accomplished through the use of a locator service.

5. The method according to Claim 1 wherein said list includes service information for each of the service providers.

6. The method according to Claim 1 further including the step of providing an icon for the selected service provider.

7. The method according to Claim 6 wherein the icon for the selected service provider is displayed in a user interface screen.

8. The method according to Claim 7 wherein the icon for the selected service provider is displayed in place of a generic icon.

9. The method according to Claim 7 wherein the icon for the selected service provider comprises a trademark.

10. The method according to Claim 1 wherein said requester selecting one of said plurality of different service providers from said list further comprises displaying a list of service providers and service information for at least one of the listed service providers.

11. The method according to Claim 1 wherein said criterion is directly associated with data included in the digital image file.

12. A method according to Claim 11 wherein said data includes a camera manufacturer of a digital camera that captured said selected one of said plurality of digital images.

13. A method according to Claim 1 wherein the service provider is positioned on said display device according to a business criteria.

14. A method according to Claim 13 wherein said business criteria is based on a retailer who sold the digital camera that captured said selected one of said plurality of digital images.

15. A method according to Claim 13 wherein said business criteria is based on a digital camera make.

16. A method according to Claim 13 wherein said business criteria is based on a language selected by the user.

17. A method according to Claim 1 further wherein said selected one of said plurality digital images was captured by a digital camera.

18. A method according to Claim 17 wherein the selected service is producing hardcopy prints of the selected images.

19. A method according to Claim 18 further including the step of selecting a print quantity for the selected images.

20. A system for providing imaging services over a communications network, including:
- a) a first device having a user interface for receiving commands from a user and a network interface;
 - b) a plurality of unrelated different service providers connected to said communication network;
 - c) a computer having a network interface for communication to said first device over said communication network, wherein said computer having a services directory having entries for a plurality of unrelated different service providers, each of said plurality of different service providers having associated information;
 - d) wherein the user, using said first device, provides at least one criterion;
 - e) said computer automatically provides a list of at least one of said plurality of different service providers based on the criterion, using said associated information;
 - f) said selected service provider providing said requested service.

21. A computer software product for linking a digital camera user to a service provider selected from a plurality of service providers, said computer software program will when loaded on to a computer will cause the computer to do the following steps:

- a) providing a services directory that is accessible over a communication network which includes entries for a plurality of unrelated service providers;
- b) communicating at least one criterion from the digital camera user over a communication network to said service directory;
- c) automatically providing the digital camera user with a list of one or more of said plurality of different service providers based on the criterion;
- d) said digital camera user selecting one of said plurality of different service providers from said list over said communication network;
- e) providing a request for a desired service to the selected service provider over said communication network; and
- f) providing of said desired service by said selected service provider.

22. A method of linking a digital photographic imaging service requester to a service provider selected from a plurality of different unrelated service providers that are registered in a member system, comprising:

- a) providing a services directory that is accessible over a communication network which includes entries for a plurality of services, each service associated with at least one of said plurality of different service providers;
- b) the service requester providing at least one digital image and at least one criterion over said communication network;
- c) automatically providing the requester over said communication network with a list of one or more of said plurality of different service providers based on said criterion;
- d) said requester selecting over said communication network one of said plurality of different service providers from said list;
- e) providing a request for a desired service and providing said digital image to the selected service provider over said communication network; and
- f) providing of said desired service by said selected service provider.